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Paper No. 17

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DEC 1 6 2003

OFFICE OF PETITIONS

In re Application of :
Sujian Huang et al. :
Application No. 09/635,116 :
Filed: August 9, 2000 :
For: METHOD FOR SIMULATING DRILLING :
OF ROLLER CONE BITS AND ITS :
APPLICATION TO ROLLER CONE BIT :
DESIGN AND PERFORMANCE :

DECISION ON PETITION

The above-identified application is before the Deputy Commissioner for Patent Examination Policy for review. As a result of that review --

(1) the third-party petition to withdraw the above-identified application from issue filed on April 15, 2003 is **dismissed**;

(2) the decision of October 9, 2003 by the Director of Technology Center 2100 (Technology Center Director) is **vacated**;

(3) the request for reconsideration of the decision of October 9, 2003 by the Technology Center Director filed on October 16, 2003 is **dismissed**; and

(4) the above-identified application is returned to the Office of Patent Publication for further processing.

BACKGROUND

A paper on behalf of a third party to the above-identified application was filed on April 15, 2003. The paper filed on April 15, 2003 contained a protest under 37 CFR 1.291, and a petition under 37 CFR 1.313 to withdraw the above-identified application from issue.

The petition under 37 CFR 1.313 to withdraw the above-identified application from issue was denied by the Technology Center Director in a decision mailed on October 9, 2003.

A third-party paper requesting reconsideration of the Technology Center Director's decision of October 9, 2003 was filed on October 16, 2003.

STATUTE AND REGULATION

35 U.S.C. § 2(b)(2)(A) provides that the Office may establish regulations, not inconsistent with law, which shall govern the conduct of proceedings in the Office.

35 U.S.C. § 151 provides that:

If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.

Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof, and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.

If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the Director as though no abandonment or lapse had ever occurred.

37 CFR 1.313 provides that:

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this

section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary. A petition under this section is not required if a request for continued examination under § 1.114 is filed prior to payment of the issue fee. If the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application.

(b) Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except:

- (1) A mistake on the part of the Office;
- (2) A violation of § 1.56 or illegality in the application;
- (3) Unpatentability of one or more claims; or
- (4) For interference.

(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:

(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;

(2) Consideration of a request for continued examination in compliance with § 1.114; or

(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

(d) A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. Withdrawal of an application from issue after payment of the issue fee may not be effective to avoid publication of application information.

DECISION

The Technology Center Group Director's decision of October 9, 2003

The Manual of Patent Examining Procedure (MPEP) provides that petitions, or requests at the initiative of the USPTO by someone other than a Technology Center Director, to withdraw patent applications from issue after payment of the issue fee under 37 CFR 1.313(b) and (c) are decided by the Office of the Deputy Commissioner for Patent Examination Policy. See MPEP 1002.02(b) (8th. ed. 2001) (Rev. 1, Feb. 2003). The decision of October 9, 2003 denying the third-party petition filed April 15, 2003 to withdraw the above-identified application from issue, however, was rendered by the Technology Center Director, rather than Office of the Deputy

Commissioner for Patent Examination Policy.¹ Therefore, the decision of October 9 2003 is hereby **vacated**.

The third-party request for reconsideration submitted on October 16, 2003

37 CFR 1.313 provides for the withdrawal of an application from issue for further action either: (1) at the initiative of the Office; or (2) upon petition by the applicant. See 37 CFR 1.313(a). 37 CFR 1.313 provides that after payment of the issue fee, the Office may withdraw the application from issue after payment of the issue fee at its own initiative: (1) due to a mistake on the part of the Office; (2) due to a violation of 37 CFR 1.56 or illegality in the application; (3) due to unpatentability of one or more claims; or (4) for interference. See 37 CFR 1.313(b). 37 CFR 1.313 provides that after payment of the issue fee, the Office may withdraw the application from issue after payment of the issue fee upon petition by the applicant for: (1) unpatentability of one of more claims; (2) consideration of a request for continued examination in compliance with 37 CFR 1.114; or (3) express abandonment of the application. 37 CFR 1.313 does not permit a third party to petition the Office to withdraw an application from issue for any reason.²

The Court of Appeals for the Federal Circuit (Federal Circuit) has refused to accord standing to third parties challenging Office actions (outside of the an interference) during the prosecution of an application for patent. See Animal Legal Defense Fund v. Quigg, 932 F.2d 920, 930, 18 USPQ2d 1677, 1685 (Fed. Cir. 1991) (“We find nothing in the law which gives rise to a right in nonapplicants to object to the way in which patent applications of others are prosecuted. A third party has no right to intervene in the prosecution of a particular patent application to prevent the issuance of an allegedly invalid patent”). The Office has promulgated regulations permitting third parties to file protests and petitions for public use proceedings in applications that have not been published under 35 U.S.C. § 122(b) and 37 CFR 1.211 et seq. (37 CFR 1.291 and 1.292) and to file prior art submissions in applications that have been published under 35 U.S.C. § 122(b) and 37 CFR 1.211 et seq. (37 CFR 1.99). The rules of practice, however, do not permit a third party to petition the Office to withdraw an application from issue. The fact that the Office

¹ It appears that the third-party petition filed April 15, 2003 to withdraw the above-identified application from issue was forwarded by the Office of Petitions to Technology Center Director for decision.

² The petition of April 15, 2003 also request that the Office withdraw the application from issue *sua sponte* (or on its own initiative) if petitioner is deemed to lack standing in the above-identified application. *Sua sponte* means: Of his or its own will or motion; voluntarily; without prompting or suggestion. See Black's Law Dictionary at 1424 (6th ed. 1990). Thus, the filing of a paper prompting or suggesting that the Office take action *sua sponte*, much less the filing of a paper requesting reconsideration of a decision not to take action in an application *sua sponte*, is a *non sequitur*.

does permit a third party to file certain papers in an application does not afford a third party with standing to challenge Office decisions in that application. Cf. Boeing Co. v. Commissioner of Patents and Trademarks, 853 F.2d 878, 881, 7 USPQ2d 1487, 1489 (Fed. Cir. 1988)(that a third party is permitted to participate in district court action concerning a reexamination proceeding does not imply that the third party has standing to appeal a district court decision favorable to patent owner).

Petitioner lacks standing to request that the Office withdraw the above-identified application from issue. Accordingly, the third-party petition under 37 CFR 1.313 filed on April 15, 2003, and the third-party request for reconsideration of the Technology Center Director's decision of October 9, 2003 filed on October 16, 2003, are **dismissed**.

This decision is being copied to Charles L. Gholz of Oblon, Spivak, McClelland, Maier & Neustandt, P.C., 1940 Duke Street, Alexandria, VA 22314. However, no further correspondence concerning the above-identified application will be undertaken with Oblon, Spivak, McClelland, Maier & Neustandt, P.C. See 37 CFR 1.291(c).

Petitioner's representative is placed on notice that the Office considers the filing of a petition or other paper on behalf of a party having no standing in an application, and not otherwise authorized by the rules of practice, to be a paper presented for an improper purpose (37 CFR 10.18). For example, the filing of a paper on behalf of a party in situations not authorized by the rules of practice delays the examination and processing of applications, which may cause harm to the general public if it results in the Office missing any one of the examination time frames specified in 35 U.S.C. §§ 154(b)(1)(A) or 154(b)(1)(B). Therefore, the Office may refer any further third-party petitions in this or any other application to the Office of Enrollment and Discipline for appropriate action.

CONCLUSION

For the above-stated reasons:

(1) the third-party petition to withdraw the above-identified application from issue filed April 15, 2003 is **dismissed**;

(2) the decision of October 9, 2003 by the Technology Center Director is **vacated**; and

(3) the third-party request for reconsideration of the decision of the request for reconsideration of the decision of October 9, 2003 by the Technology Center Director filed on October 16, 2003 is **dismissed**.

This decision may be viewed as final agency action. See MPEP 1002.02(b).

Telephone inquiries related to this decision should be addressed to Petitions Examiner Brian Hearn at (703) 305-1820.

The above-identified application is returned to the Office of Patent Publication for further processing.



Stephen G. Kunin
Deputy Commissioner for
Patent Examination Policy

cc:

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